

## REMARKS

The last Office Action of February 3, 2005 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-11 are pending in the application. Claims 1 and 9 have been amended. No claims have been canceled or added. No amendment to the specification has been made.

Claims 1-11 are rejected under 35 U.S.C. §101 for including method steps in the apparatus claims.

Claims 1-7 are rejected under 35 U.S.C. §112, second paragraph, for the same reason, namely for including method steps in the apparatus claims. Claims 9-11 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to specify what the moved mass is in relation to the structure of the claimed invention.

Claims 1, 2, and 7-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,658,600 to Okada et al. (hereinafter "Okada") in view of U.S. Pat. No. 6,533,972 to Stirn (hereinafter "Stirn").

Claim 3 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Okada in view of Stirn, and further in view of U.S. Pat. No. 5,499,916 to Schad (hereinafter "Schad").

Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Okada in view of Stirn, and further in view of U.S. Pat. No. 4,482,101 to Fink (hereinafter "Fink").

No prior art has been cited against claims 4-6, which are presumed to be allowable after overcoming the rejections under 35 U.S.C. §101 and 35 U.S.C. §112.

#### **REJECTIONS UNDER 35 U.S.C. §101 and §112, SECOND PARAGRAPH**

The rejections have been overcome by amendments to claims 1 and 9. In addition, regarding the incorporation of functional language in apparatus claims, the examiner is directed to MPEP §2114 which states that "While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. [*In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997)]. Applicant therefore requests that the Examiner takes into account the structural differences between the claimed invention and the prior art, regardless of the functional language used. Withdrawal of the rejections under 35 U.S.C. §101 and §112, second paragraph, is therefore requested.

#### **REJECTION UNDER 35 U.S.C. §103(a)**

Claim 1, as amended herein, recites an injection molding machine with an

actuating drive constructed in the form of a spindle drive having an electric motor. The spindle drive moves between a first end position and a second end position and has an equilibrium position between and distal from the end positions. The injection molding machine further includes a dual energy storage device operatively connected with the spindle drive. The dual energy storage device receives energy from the spindle drive in the first end position and transfers energy to the spindle drive in the second end position. The transferred energy boosts the power of the electric motor.

The Examiner asserts that Okada shows a "spindle drive (19)" for force transmission. However, as stated clearly in col. 4, lines 35-47, in the Okada reference, the cited element 19 is a hydraulic cylinder type vibration generator which operated by way of a proportional flow valve and a servo valve. Okada does not disclose or suggest using a spindle drive.

Moreover, the springs (30, 34) disclosed by Okada are provided to resiliently connect the vibration shaft (20) and the cylindrical receiving member (27) via spring (34) and the cylinder (31) with the rod member (28). However, the two springs do not receive energy from the vibration shaft (20) in a first end position and transfer energy to the vibration shaft (20) in a second end position, as recited in amended claim 1.

Stirn does also not disclose a spindle drive. The motor (40) disclosed by Stirn drives an ejector arm (50) via a transmission (44), with a control system (80) detecting a stalled condition of the motor, which is entirely different from locking the spindle drive in an end position. There is no suggestion in the Stirn

reference that the ejector arm could be a spindle. There is also no suggestion that energy can be transferred to the spindle drive in an end position to boost the power of the electric motor.

For the reasons set forth above, it is Applicant's contention that Stirn and Okada, taken alone or in combination, do not disclose or suggest the elements and their cooperation as recited in claim 1. Schad and Fink do not disclose the features missing from the Stirn and Okada references.

As for the rejection of the retained dependent claims, claims 4-6 are allowable since no art was cited against these claims. The other dependent claims depend on claim 1, share its presumably allowable features, and therefore it is respectfully submitted that these claims should also be allowed.

Withdrawal of the rejection under 35 U.S.C. §103(a) and allowance of claims 1-11 are thus respectfully requested.

## **CITED REFERENCES**

Applicant has also carefully scrutinized the further cited prior art and finds it without any relevance to the newly submitted claims. It is thus felt that no specific discussion thereof is necessary.

## **CONCLUSION**

In view of the above presented remarks and amendments, it is respectfully

submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Applicant further submits a certified copy of the priority document under 35 U.S.C. §119(a)-(d).

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

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